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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/065,248	09/27/2002	Doris MacAllister	02-094-DM	2124

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LAMBERT & ASSOCIATES, P.L.L.C.

92 STATE STREET

BOSTON, MA 02109-2004

EXAMINER

PHAM, HUONG Q

ART UNIT

PAPER NUMBER

3772

DATE MAILED: 11/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/065,248

Applicant(s)

MACALLISTER, DORIS

Examiner

Huong Q. Pham

Art Unit

3772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 August 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 September 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The finality of the previous Office action is hereby withdrawn.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the subject matter in claim 6 must be shown or the feature(s) canceled from the claim(s). Note that it is unclear how the device is secured to an arm and shoulder.

No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner,

the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 19, 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

“ the appendage securing section” lacks proper antecedent basis.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 5, 7- 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Kawasaki et al (5,486,194).

As for claims 1,5, Kawasaki et al teaches a device capable of prevention of the abnormal joint rotation (when the device is wrapped around a person as shown in figures 5A –5C and 11A-11B, it can perform the functions as claimed), comprising an

appendage securing section constructed and arranged to secure to an appendage , a torso securing section having means for coupling to the appendage securing section(note figures 5A –5C and 11A-11B) , wherein the torso securing section is constructed and arranged to secure to the torso of the patient and capable of applying correcting pressure directed upon the appendage securing section, wherein the correcting pressure exerted by the torso securing section upon the appendage securing section is capable of countering the direction of the abnormal joint rotation. As for claims 2-3, 8 - 12, the device of Kawasaki et al is capable of applying the recited correcting pressure. As for claim 7, note that the band of Kawasaki et al is made of low-stretchable fiber, and therefore has certain degree of elasticity. As for claim 13, note that the appendage securing section of Kawasaki et al has a first end and a second end; and the torso securing section has a first end, an intermediate section, and a securing end, wherein the securing end of the torso securing section has means for coupling to the appendage securing section (figures 5A- 5C) . As for claims 14, 15, the appendage securing section of Kawasaki et al has means 11 for coupling of the first end of the appendage securing section to the second end of the appendage securing section. As for claims 16, 17, note that the torso securing section of Kawasaki et al has means for coupling of the first end of the torso securing section to the intermediate section of the torso securing section (all sections are connected) . As for claim 18, note that the second end of the appendage securing section is joined to the first end of the torso securing section thereby forming a wrap.

Claims 1, 3, 8, 11, 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Hori et al (5,464,420).

As for claims 1, Hori et al teaches a device capable of prevention of the abnormal joint rotation (when the device is wrapped around a person as shown in figure 16, it can perform the functions as claimed), comprising an appendage securing section constructed and arranged to secure to an appendage , a torso securing section having means for coupling to the appendage securing section , wherein the torso securing section is constructed and arranged to secure to the torso of the patient and capable of applying correcting pressure directed upon the appendage securing section, wherein the correcting pressure exerted by the torso securing section upon the appendage securing section is capable of countering the direction of the abnormal joint rotation. As for claims 3, 8, 11 -12, the device of Hori et al is capable of applying the recited correcting pressure to counter the direction of the internal rotation of the joint.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kawasaki et al in view of Engel.

Note the comments above for the teaching of Kawasaki et al. Engel teaches magnets secured on a torso securing device for magnetic therapy (figure 4). In view of the teaching of Engel, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a magnetic body to the torso securing section of Kawasaki et al to provide magnetic treatment to a user.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kawasaki et al.

Note the comments above for the teaching of Kawasaki et al. As for claim 6, note that the device of Kawasaki et al has a structure which is capable of being used on a shoulder joint.

Allowable Subject Matter

Method claims 19, 20 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments filed on August 28,2006 have been fully considered but they are not persuasive. Note the comments and explanation relative to the claims above. Note that Kawasaki teaches that his device can be made of " low stretch fiber", this means that the device has some degree of stretching or "elastic" as recited .

Art Unit: 3772

Applicant argues that Kawasaki is a single band... and the torso section and the appendage section are separate elements.....Note that applicant claims read on the embodiment of applicant's figures 3-14 which is a single band. Applicant argues that "there would be no motivation to wrap the device of Kawasaki around the shoulder....". Note in the discussion above that Kawasaki 's device has the structure as recited in the claim , and if applicant 's device, as recited , is capable of being wrapped around the shoulder, so is the device of Kawasaki. Applicant argues that " nothing in Kawasaki is design to counter the direction of the external rotation of the joint". Note that Kawasaki et al' s device, as shown in figures 5A- 5C, includes all elements of applicant's device as recited in the claims , and is wrapped around the thigh and torso in similar manner. Therefore, if applicant 's device, as recited , is capable of countering the direction of abnormal rotation of the joint, so is the device of Kawasaki.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Huong Q. Pham whose telephone number is (571) 272-4980. The examiner can normally be reached on 8:45 AM - 5:15 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patricia Bianco can be reached on (571) 272 - 4940. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3772

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

November 2, 2006

El Bruno
nl810